

October 20, 2005
US Serial No. 10/035,215
Reply to June 21, 2005 Office Action

Remarks

Claims 1, 3, 6, 8, 10, 12, 13 and 15 are amended, claims 5, 7, 11 and 41 – 43 are cancelled, and new claims 56 – 71 are added hereby.

Claims 1 – 3, 6, 8 – 10, 12 – 17 and 56 – 71 are now pending.

Examiners Haas and Grunberg are thanked for the courtesies extended to the undersigned and the inventors, Drs. John and Susan Woods, during the personal interview conducted on October 4, 2005, the substance of which is gratefully incorporated into this response. The Examiners were particularly helpful in suggesting approaches to arriving at allowable subject matter, which have been incorporated by way of the present amendments. In particular, the examiners suggested that the incorporation of the macropropagation aspect of the present invention as a further step(s) in independent claim 1 would appear to present patentable subject matter, pending a confirmatory search. While Applicants remain of the position held at the interview that the prior art rejections of the Office Action of June 21, 2005, are not sufficient in establishing *prima facie* cases of obviousness, the amendments herein have been made in order to expedite allowance of this application, without prejudicing Applicants' right to pursue the previous claims in another application.

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By way of the amendments made, no new matter is introduced. Basis for the new claims and claim amendments may be found throughout the originally filed specification and claims. More particularly, the method of independent claim 1 now includes the macropropagation aspect of the invention, which had been previously set forth in original claim 19 (and claimed in tandem with the micropropagation as claim 20, for instance), as well as disclosed in the "Macropropagation" section beginning on page 14 of the Specification. New claim 56 is based on the disclosure at page 17, line 1, and for new claims 58 – 61 at page 16, lines 13 – 17, and page 19, lines 15 – 18, and original claim 19, *inter alia*. New claim 62 is based on original claim 21, and new claim 63 is based on the disclosure at page 15, line 5. New claims 64 – 69 are based on original apparatus claims 24 – 29, respectively, and are presented here not as to claim the apparatus *per se*, but to further limit the method claims from which they depend. Finally, new claims 70 and 71 are based on original claim 32 and 34, and are presented to cast the invention in different terminology. Applicants submit that the claims are fully supported in the application as filed.

In the Office Action, certain claims were alleged to be not entitled to the prior provisional application filing date on various grounds. Concerning the issue raised in the Office Action with respect to the terminology "solid or semi-solid" as not being supported by the provisional application's use of only "semi-solid", as Applicants propounded at the interview, in the art the terminology "solid" is used

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interchangeably with "semi-solid". It is unreasonable to suggest that "solid" implies anything of increased scope or difference from "semi-solid" to justify a finding of no support; Applicants intended merely to clarify and give notice that, while those in the art may use different terminology, the words mean the same thing. Thus, the term "solid" has not been removed from the claims, particularly since to do so may be perceived as an estoppel to a fair determination of equivalents. In this regard, Applicants cite the MPEP, which states: (1) *"While there is no in haec verba requirement, newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure."*; and (2) *"The fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed."* Applicants submit that the underlying provisional application meets these requirements.

With respect to the claim 1 objection, and the rejection of claims 13 and 14 under 112, second paragraph, the present claims have taken these into consideration and have been amended accordingly. Therefore, these matters are moot.

The three prior art rejections in the Office Action based on obviousness are obviated in view of the amendments herein. While Applicants had set forth at the interview the reasons why the rejections of the previously pending claims

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could not be maintained (based primarily on the lack of teaching in the art of steps (d) and/or (e) of previous claim 1 *et seq.*), it was the examiners' opinion that they could probably be recast with additional prior art to present a *prima facie* case under section 103. While not conceding to this opinion, and to expedite allowance of this application, Applicants have opted to recite the macropropagation aspect in the main claims, which was conditionally agreed at the interview to not be disclosed or suggested in the cited prior art. In order to be completely responsive to the Office Action, Applicants submit that the combined method of propagation of *Arundo donax* plants, as now claimed in claim 1, as well as claim 70, and claims dependent therefrom, is not disclosed or suggested in the prior art of record. As explained at the interview, the methods allow for the first time the mass propagation, e.g., in the tens of thousands or more, of *Arundo* grasses, a feat never accomplished in the industry until now. Other benefits and advantages are as set forth in the application. The abilities provided by the invention as claimed have not heretofore been accomplished in the static float bed arrangements typical in the plant industry, nor has there been a way to mass produce plants of *Arundo* of a scale worthy of commercial success. Accordingly, it is urged that each and every of the section 103 rejections of record be withdrawn.

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It is respectfully submitted that the pending claims present a patentable invention, and prompt allowance is courteously requested. Should the examiner believe there are any minor issues remaining, it is kindly requested that she contact the undersigned in order to expedite the disposition of this application.

A Petition for One-month Extension of Time accompanies this paper, as well as a credit card payment in the amount of \$60 for such extension.

Respectfully submitted,



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Enclosures: Petition for One-Month Extension of Time
Credit card payment of \$60

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